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In re Application of:
YIP, YUNG
Application Serial No.: 10/755,143
Filed: January 8, 2004
For: **SYSTEM WITH MATRIX ARRAY OF
WRITE HEADS AND ARRAY OF
MAGNETORESISTIVE (MR) READ HEADS**

MAIL

MAR 25 2008

**DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600**

**DECISION
ON PETITION**

This is a decision on the petition filed December 17, 2007 to 1) reinstate withdrawn claims 21 and 22, which were withdrawn by the Examiner in the final Office Action mailed October 19, 2007 based on an improper Election Requirement, and 2) rescind the finality of the final Office Action mailed October 19, 2007 pursuant to 37 CFR § 1.181.

Petitioner alleges that the Examiner improperly refused to examine claims 21 and 22, and has failed to address Applicant's arguments as to why claims 21 and 22 are not a species relative to the genus of claim 1. The finality of the current Office Action is also improper for this reason.

PERTINENT BACKGROUND

An election of Species Requirement was mailed on August 11, 2006 requiring applicant to elect one species from three separate species identified as (A) FIG.2, (B) FIG.6, and (C) FIG.8. No claims were identified as generic to all three species.

Applicant filed a Response to the Election requirement on September 5, 2006 electing Group A FIG. 2 with traverse. The traverse is based on applicant's argument that FIG.2 is generic to FIG.6 and FIG.8 and independent claims 13 and 18 are species of the genus defined by claim 1. Applicant further indicated if examiner recognizes claim 1 (FIG. 2) is generic, applicant would elect the species of FIG 6.

A non final office action was mailed on November 7, 2006. The response to the election with traverse was found to be not persuasive. A rejection of claims 1-12 being drawn to elected species group A was made. The rest of the claims 13-20 were withdrawn from consideration as being directed to non-elected species.

Applicant filed an amendment to the claims on February 7, 2007. The amendment cancelled claims 13-20 and added new claims 21-22. Applicant again reiterated the argument for an election of species between FIG. 6 and FIG. 8 with FIG. 2 being a genus of these species. Applicant requested claims 21 and 22 be examined with remaining claims 1-12.

A non final office action was mailed April 19, 2007. The office action withdrew claims 21-22 from examination as being directed to Species C and the invention had been constructively elected as a result of an action on the merits for the originally presented invention.

Applicant filed an amendment on July 19, 2007. Applicant again reiterated the argument for an election of species between FIG. 6 and FIG. 8 with FIG. 2 being a genus of these species. Applicant disagreed with examiners refusal to examine claims 21 and 22 and argued claims 1 and 21 should be examined together, consistent with Applicant's election of the genus of FIG 2 and the species of FIG 6.

A final rejection was mailed on October 19, 2007.

On December 17, 2007, applicant filed an amendment after Final concurrently with the petition to the Director under 37 CFR 1.181.

REGULATIONS AND PRACTICE

37 CFR 1.146. Election of species.

In the first action on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable. However, if such application contains claims directed to more than a reasonable number of species, the examiner may require restriction of the claims to not more than a reasonable number of species before taking further action in the application.

MPEP 806.04 states in part:

Where an application includes claims directed to different embodiments or species that could fall within the scope of a generic claim, restriction between the species may be proper if the species are independent or distinct.

MPEP 806.04(d) states in part:

In general, a generic claim should *require< no material element additional to those **>required by< the species claims, and ** each of the species >claims must require all the limitations of the generic claim<.

MPEP 806.04(e) states in part:

Claims are definitions >or descriptions< of inventions. Claims >themselves< are never species. The scope of a claim may be limited to a single disclosed embodiment (i.e., a single species, and thus be designated a specific species claim)*>. Alternatively,< a claim may *>encompass< two or more of the disclosed embodiments** (and thus be designated a generic or genus claim).

OPINION

A review of the record indicates Figure 2 is generic to Figure 6 and Figure 8. Claim 1 is generic to all pending claims. Therefore applicant's election of the species of Figure 6 in the election of species response filed on September 5, 2006 and again repeated in the response filed July 19, 2007 is proper. A review of all of the remaining claims 1-12 and 21-22 indicate claims 1-12 are readable on the species of Figure 6. Claims 21-22 are readable on species of Figure 8. Since Figure 6 is the elected species by applicant, claims 21-22 are withdrawn from consideration. Applicant has already received an office action on all of the remaining pending claims 1-12. The Final rejection will not be withdrawn to examine claims 21-22, since claims 21-22 are drawn to a non-elected species (Figure 8).

Accordingly, the petition to reinstate withdrawn claims 21-22 is **DENIED**. The petition to rescind the finality of the current office action is also **DENIED**.

The three month shortened statutory period for response set forth in the Final Office action of October 17, 2007 continues to run. The application is being forwarded to the examiner for consideration of the Amendment After Final filed December, 17, 2007.



Andrew Faile, Director
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Communications